

REMARKS

Applicants have amended their drawings figures to show projections 37a and 37b in Figs. 1, 2, 3 and 4. In connection with this amendment of the drawing figures, the objection to the drawings under 37 CFR 1.83(a), set forth in Item 2 on pages 2 and 3 of the Office Action mailed August 12, 2008, is noted. By setting forth the projections 37a and 37b in, for example, Figs. 1 and 3, it is respectfully submitted that the drawings now clearly show every feature of the invention specified in the claims.

In this regard, the comment by the Examiner in Item 2 on page 2 of the Office Action mailed August 12, 2008, that an embodiment having both recessed portion surfaces positioned in a range, in the horizontal direction, of thickness of the third plate, and the raised portions must be shown, is noted. Thus, Figs. 1, 2, 3 and 4 show the raised portions, and in particular Fig. 3 shows the raised portions and having both recessed portion surfaces positioned in a range, in the horizontal direction, of thickness of the third plate.

Noting particularly Fig. 7 and the description in connection therewith, as well as original Fig. 3 and the description in connection therewith, it is respectfully submitted that, clearly, amendments to Figs. 1, 2, 3 and 4 do not constitute new matter.

Applicants have amended their specification on pages 5 and 6, in light of amendments to the drawing figures. Specifically, the descriptions in connection with Figs. 1 and 3 have been amended to refer to projections 37a and 37b, these projections also being shown in Figs. 2 and 4. For the same reasons that the amendments to the drawing figures themselves do not constitute new matter, it is respectfully submitted that Applicants' original disclosure, in descriptions of, inter

alia, Figs. 3 and 7, disclose the subject matter newly added to the specification herein, such that the present amendments to the specification do not constitute new matter.

Applicants have amended their claims in order to further clarify the definition of various aspects of the present invention. Specifically, Applicants have amended each of independent claims 16-19 to recite a hollow frame member adapted to be used in a friction stir welding “which is carried out by rotary tools”. Each of these independent claims has also been amended to recite that the substantially horizontal surface facing outwardly in the thickness direction of the hollow frame member is positioned within a range of a thickness of the third plate in the horizontal direction. Moreover, claims 16, 18 and 19 have been amended to recite that a second raised portion is protruded from the second plate toward a side of the further rotary tool when the friction stir welding of the second plate is being performed and is plasticized by the further rotary tool during the friction stir welding of the second plate; and each of independent claims 16-19 has been amended to recite that the third plate sustains a vertical force produced by the rotary tool during the friction stir welding of the second plate. Claim 17 has been still further amended to recite that the third plate, which is substantially perpendicular to the first and second plates, extends in a thickness direction of the member. Claim 15 has been amended in light of amendments to claim 18.

Claims 20-24 have been amended such that each of these claims recite that the horizontal surfaces are positioned adjacent “said” third plate in “said” range of thickness of the third plate “in said horizontal direction”.

Initially, it is respectfully requested that present amendments to the drawings, specification and claims be entered. Noting, inter alia, Figs. 3 and 7 as previously

before the Examiner, as well as descriptions in Applicants' specification in connection therewith, including portions referred to previously herein, it is respectfully submitted that the present amendments to the drawings and specification do not raise any new issues; and, moreover, in light of issues raised by the Examiner in the Office Action mailed August 12, 2008, in connection with the objection to the drawings, it is respectfully submitted that the present amendments do not raise any new issues. Emphasizing that the Examiner objected to the drawings for the first time in the Office Action mailed August 12, 2008, it is respectfully submitted that the present amendments to the drawings and specification are clearly timely. Furthermore, noting that the present amendments to the drawings clearly overcome the objection to the drawings made for the first time in the Office Action mailed August 12, 2008, and that the amendments to the specification have been made such that the specification is consistent with the amended drawings, it is respectfully submitted that the present amendments to the drawings and specification materially limit issues remaining in connection with the above-identified application.

Moreover, it is respectfully submitted that the present amendments to the claims do not raise any new issues, including any issue of new matter; and materially limit issues remaining in connection with the above-identified application. In this regard, note that with the present amendments to the claims, the claims are consistent in reciting raised portions protruding from the respective plates toward a side of the specified rotary tool "when friction stir welding" of the respectively plate is being performed; and noting especially comments by the Examiner in Item 5 on page 4 of the Office Action mailed August 12, 2008, that the claims would be allowable "if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112,

2nd paragraph, set forth in [the Office Action mailed August 12, 2008]”, it is respectfully submitted that the present amendments materially limit issues remaining in connection with the above-identified application, and present all claims in condition for allowance. Noting the new basis for rejection in the Office Action mailed August 12, 2008, under 35 USC 112, second paragraph, it is respectfully submitted that the present amendments in connection with the indefiniteness rejection are clearly appropriate under 37 CFR 1.116.

In view of all of the foregoing, it is respectfully submitted that the necessary showing under 37 CFR 1.116 has been made, with respect to all of the present amendments to the specification, drawings and claims, and that, accordingly, entry of the present amendments is clearly proper.

As set forth in the foregoing, and for reasons set forth therein, it is respectfully submitted that the presently amended drawings overcome the objection under 37 CFR 1.83(a) on pages 2 and 3 of the Office Action mailed August 12, 2008.

The rejection of all claims pending in the application under the second paragraph of 35 USC 112, set forth in Item 4 on page 3 of the Office Action mailed August 12, 2008, is respectfully traversed, insofar as applicable to the claims as presently in the application. Thus, each of the independent claims recites that the raised portion is protruded from the respective plate toward a side of the rotary tool “when the friction stir welding [of the respectively plate] is being performed”. It is respectfully submitted that defining, e.g., location of the raised portion with respect to the use thereof is appropriate, noting that the present claims recite a hollow frame member adapted to be used in a friction stir welding which is carried out by rotary tools. Accordingly, particularly insofar as the present claims are amended, it is

respectfully submitted that the rejection under the second paragraph of 35 USC 112, as being indefinite, is moot.

The contention by the Examiner that the frame members are being claimed alone, not in combination with a rotary tool, and as such should not rely upon the rotary tool to define an element or direction, is respectfully traversed. Thus, it is respectfully submitted that defining the location of the raised portions, with respect to the use thereof, is appropriate and sufficiently defines the metes and bounds of the present invention, as required under 35 USC 112, second paragraph. See In re Moore, 169 USPQ 235 (CCPA 1971).

Such conclusion that the present claims are definite, by defining location of the raised portion with respect to position of the rotary tool, is particularly appropriate under the present claim recitations, in which the hollow frame member is defined as being adapted to be used in a friction stir welding “which is carried out by rotary tools”, and wherein various recitations in the claims specify, for example, that the recessed portion (and second recessed portion) is a portion capable of having friction stir welding carried out therein by inserting rotary tools therein, and that in the friction stir welding, a center of the rotary tool is inserted into the hollow frame member and is substantially coincided with an extension line of the vertical surface facing outwardly laterally to the thickness direction of the hollow frame member. Note each of claims 16, 17, 18 and 19.

In view of the foregoing comments and amendments, entry of the present amendments, and reconsideration and allowance of all claims presently pending in the above-identified application, and entry of the present amendments to the drawings and to the specification, are respectfully requested.

To the extent necessary, Applicants hereby petition for an extension of time under 37 CFR 1.136. Kindly charge any shortage of fees due in connection with the filing of this paper, including any extension of time fees, to the Deposit Account of Antonelli, Terry, Stout & Kraus, LLP, Account No. 01-2135 (case 503.35255VX6), and please credit any overpayments to such Deposit Account.

Respectfully submitted,

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